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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,092	07/21/2000	Solomon S. Steiner	PDC 116	4836

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EXAMINER

PATEL, MITAL B

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/621,092

Applicant(s)

STEINER ET AL.

Examiner

Mital B. Patel

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-30, 33-36 and 41-45 is/are pending in the application.
- 4a) Of the above claim(s) 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-30 and 41-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3761

## DETAILED ACTION

### *Election/Restrictions*

1. Please note that this Office Action is in response to the Election/Restriction requirement date 7/2/02. Please also note that the Examiner maintains the original requirement of election of the species, in which case the Applicant has elected Species I of the Group II claims. Therefore, claims 28-30 and 41-45 will be considered on the merits.

### *Drawings*

2. Formal drawings were submitted by the Applicant on 7/1/02. However, page 10 which includes Figures 18 and 19 is missing. Please resubmit page 10 of the Formal drawings.

### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally **limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.** The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 28-30, 41-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. As set forth by Claim 41, there is an inconsistency between the language in the preamble and certain portion or portions in the body of the claim, thereby making the scope of the claim unclear. The Applicant must clarify what the claim is intended to be drawn to, i.e., either the capsule alone or the combination of the capsule and the inhaler. The Applicant must make the language of the claim consistent with the intent. It appears that the Applicant intends to claim the capsule alone and if such is the case, the Examiner suggests the following language for claim 41--a capsule to contain drug for use in an inhaler comprising a keying surface that is **adapted to orient** the capsule within the inhaler or identifies the drug to be placed in the capsule--. Please also note that the Examiner suggest the above mentioned --adapted to-- language for claims 42-45 as well.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3761

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Yang (US 5632971).

9. **As to claim 41**, Yang teaches a capsule to contain drug for use in an inhaler comprising a keying surface that orients the capsule within the inhaler or identifies the drug to be placed in the capsule.

10. **As to claim 28**, Yang teaches a capsule having a first tube 1 and a second tube 2, wherein a first tube having a long axis, having an inner and an outer surface radial to the long axis, wherein the tube is open at one end perpendicular to the long axis, wherein the first tube has at least one protrusion on its outer surface; and a second tube having a long axis, having an inner and an outer surface radial to the long axis, wherein the tube is open at one end perpendicular to the long axis, wherein the tube is open at one end perpendicular to the long axis and closed at one end perpendicular to the long axis and wherein the second tube has at least one protrusion on its inner surface; and wherein the outer circumference of the first tube is approximately equal to the inner circumference of the second tube, such that the open end of the first tube can slide snugly into the open end of the second tube; and wherein a protrusion on the outer surface of the first tube may slide past a protrusion on the inner surface of the second tube, locking the tubes together; and wherein the first tube and the second tube each have one or more secondary holes other than the openings at the end of each tube, wherein at least one secondary hole in the first tube may be made coincident with at least one secondary hole in the second tube when the first tube is slid onto the second

Art Unit: 3761

tube in the unlocked position by rotation of the first and second tubes about their long axes, and wherein the first tube is locked onto the second tube at least two secondary holes in the first tube may be made coincident with at least two secondary holes in the second tube by rotation of the first and second tubes about their axes (**See Col. 3, lines 17-44**).

11. **As to claim 30**, Yang teaches a capsule further including medicament selected from the group consisting of liquid, powder, and gaseous medicaments.

12. **As to claim 42**, Yang teaches a capsule wherein the keying surface is found on a closed end on the capsule.

13. **As to claim 43**, Yang teaches a capsule wherein the keying surface orients the capsule within the inhaler.

14. **As to claim 44**, Yang teaches a capsule wherein the keying surface identifies the drug to be placed in the capsule.

15. **As to claim 45**, Yang teaches a capsule comprising a keying surface on one end which orients the capsule within the inhaler and a keying surface on the other end which identifies the drug to be placed in the capsule.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3761

17. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang.

18. **As to claim 29**, Yang teaches essentially all of the limitations except for wherein the first tube comprises a keying surface at the closed end of the tube. However, Applicant has not stated how the particular location of a keying surface is advantages over another location, or solves a stated problem or provides an unexpected result. One of ordinary skill in the art would expect the keying surface of Yang to perform equally as well despite its location on the tube.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4792451 and US 3823843.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aaron Lewis can be reached on 703-308-0716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4520 for regular communications and 703-306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

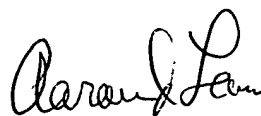
Application/Control Number: 09/621,092

Page 7

Art Unit: 3761

mbp

November 16, 2002

A handwritten signature in black ink, appearing to read "Aaron J. Lewis".

Aaron J. Lewis  
Primary Examiner